

III. REMARKS/ARGUMENTS

A. Status of the Application

Claim 1 is amended. Claims 66 – 77 are added. Thus, claims 1 – 77 are now pending. Reconsideration of this application in light of the following remarks is respectfully requested.

B. Restriction Requirement

Restriction to one of the following inventions was required by the Examiner under 35 USC 121:

- I. Claims 1 – 46, drawn to a method of performing operations in a wellbore.
- II. Claims 47 – 65, drawn to a composition.

The election made with traverse on October 3, 2005 to prosecute the invention of Group I, claims 1 – 46, is confirmed.

As grounds for traversal, Applicants submit that the claims of Groups I and II are related as a method for performing operations in a wellbore, and compositions used in such methods. Accordingly, the claims of Groups I and II can be searched without undue burden on the Examiner. Thus, Applicants respectfully request the consideration of claims 47 – 65 (Group II) in the present application.

C. Rejection under 35 USC § 102(b) over Terry

Claims 1, 4, 8, 10 – 15, 19 – 22, 25, 26, 29, 34 – 37 and 41 – 44 stand rejected under 35 USC § 102(b) over U.S. Patent No. 5,711,383 to Terry et al. (“Terry”). This rejection is respectfully traversed.

Terry describes a method of drilling a subterranean wellbore with a drilling fluid comprising water, a water viscosity increasing material and a cementitious material. (Abstract). The cementitious material in the drilling fluid is deposited on the walls of the wellbore as part of the filter cake, and consolidates the filter cake into a stable mass. (Abstract). In certain embodiments, the cementitious material comprises a silicious-containing substance, an example of which is zeolite. (col. 4, lines 18 – 22).

As provided in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim ...”. Terry fails to meet the requirements of MPEP § 2131 with respect to claims 1, 4, 8, 10 – 15, 19 – 22, 25, 26, 29, 34 – 37 and 41 – 44 because Terry fails to teach every element of these claims.

Claims 1 and 25 are independent. Claim 1 is drawn to a method of performing drilling operations that includes drilling a wellbore with a mud, introducing a wellbore treating fluid comprising zeolite and at least one carrier fluid into the wellbore, and forming a mass in the wellbore by allowing the wellbore treating fluid to come into contact with the mud in the wellbore. Claim 25 is drawn to a method of performing remedial operations in a wellbore that includes introducing a wellbore treating fluid comprising zeolite and at least one carrier fluid into the wellbore, forming a mass in the wellbore by allowing the wellbore treating fluid to come into contact with a mud residing in at least one space in the wellbore, and sealing the at least one space in the wellbore with the mass.

According to each of the methods described by claims 1 and 25, a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud. Such methods are not disclosed, motivated, or suggested by Terry.

Rather, Terry describes a method in which zeolite can be present in the drilling fluid itself. According to the method described by Terry, zeolite from the drilling fluid is deposited on the walls of the wellbore as part of the filter cake, and consolidates the filter cake into a stable mass. Subsequent fluids, for example, a cement slurry, may be pumped into the wellbore. Terry is completely devoid of disclosure, motivation or suggestion for including zeolite in any fluid other than the drilling fluid used to drill the wellbore. Thus, Terry simply cannot disclose, motivate or suggest methods in which a subsequent fluid containing zeolite, such as the wellbore treating fluid described by claims 1 and 25, is brought into contact with a mud already present in the wellbore.

In view of the foregoing, Applicants submit that Terry fails to meet the requirements of MPEP § 2131 with respect to claims 1 and 25 because Terry fails to teach every element of these claims. Accordingly, Applicants respectfully request that the rejection of claims 1 and 25 under 35 USC §102(b) over Terry be withdrawn.

Each of claims 4, 8, 10 – 15 and 19 – 22 depends directly or indirectly from claim 1, and therefore each includes at least the same elements as claim 1. Each of claims 26, 29, 34 – 37 and 41 – 44 depends directly or indirectly from claim 25, and therefore each includes at least the same elements as claim 25. Accordingly, Applicants request that the rejection of claims 4, 8, 10 – 15, 19 – 22, 26, 29, 34 – 37 and 41 – 44 be withdrawn for at least the same reasons that apply to claims 1 and 25.

D. Rejection of Claims 16 – 18 and 38 – 40 under 35 USC § 102(b) or § 103(a)

Claims 16 – 18 and 38 – 40 stand rejected under 35 USC § 102(b), or in the alternative, under 35 USC § 103(a), over Terry. This rejection is respectfully traversed.

Each of claims 16 – 18 depends directly or indirectly from claim 1, and therefore each includes at least the same elements as claim 1. Each of claims 38 – 40 depends directly or indirectly from claim 25, and therefore each includes at least the same elements as claim 25. Thus, each of claims 16 – 18 and 38 – 40 is drawn to a method in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud.

Terry describes a method in which zeolite can be present in the drilling fluid itself. According to the method described by Terry, zeolite from the drilling fluid is deposited on the walls of the wellbore as part of the filter cake, and consolidates the filter cake into a stable mass. Subsequent fluids, for example, a cement slurry, may be pumped into the wellbore.

Terry fails to provide disclosure, motivation or suggestion of the subject matter described in claims 16 – 18 and 38 – 40, and therefore cannot support the present rejections under 35 USC §§ 102(b) or 103(a).

1. Rejection under 35 USC § 102(b)

To sustain the present rejection of claims 16 – 18 and 38 – 40 under § 102(b), MPEP § 2131 requires that Terry teach every element of the claims. As discussed above with respect to the rejection of claims 1, 4, 8, 10 – 15, 19 – 22, 25, 26, 29, 34 – 37 and 41 – 44 under 35 USC § 102(b) over Terry, Terry is completely devoid of disclosure, motivation or suggestion for including zeolite in any fluid other than the drilling fluid used to drill the wellbore. Thus, Terry simply cannot disclose, motivate or suggest methods in which a subsequent fluid containing

zeolite, such as the wellbore treating fluid described by claims 16 – 18 and 38 – 40, is brought into contact with a mud already present in the wellbore.

Accordingly, Terry fails to meet the standard required by MPEP § 2131 to sustain the present rejection of claims 16 – 18 and 38 – 40 under 35 USC § 102(b). Applicants further submit that Terry entirely fails to disclose, motivate or suggest the subject matter of each of claims 16 – 18 and 38 – 40, and therefore request that the present rejection of these claims under 35 USC § 102(b) be withdrawn.

2. Rejection under 35 USC § 103(a)

To sustain the present rejection of claims 16 – 18 and 38 – 40 under 35 USC § 103(a), a prima facie case of obviousness must be established. MPEP § 2142 provides that a prima facie case of obviousness requires three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. In the present case, Terry fails to satisfy any of the criteria set forth in MPEP § 2142 with respect to claims 16 – 18 and 38 – 40.

As discussed above with respect to the rejection of claims under 35 USC § 102(b) over Terry, Terry fails to disclose, motivate, or suggest methods in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud. Accordingly, Terry cannot satisfy at least one of the elements of the prima facie case of obviousness, and therefore the entire case must fail.

Further however, there is no motivation or suggestion to modify the methods described by Terry, nor is there a reasonable expectation of success for doing so. According to the methods described by Terry, zeolite is deposited from a drilling fluid onto the walls of the wellbore as part of the filtercake. According to the methods described by claims 16 – 18 and 38 – 40, zeolite is not deposited from a drilling fluid onto the walls of the wellbore as part of the filtercake, but rather the zeolite is present in a subsequently introduced fluid that contacts a mud already present in the wellbore.

Filtercake deposition is an event known by those of ordinary skill in the art to occur during the shut down period that follows the drilling stage of wellbore formation. (*See e.g.*,

Specification at para. [0003].) Thus, to move the zeolite from the drilling fluid, as described by Terry, into a wellbore treating fluid, as described in claims 16 – 18 and 38 – 40, would render Terry inoperable for its intended purpose because if the zeolite were not present in the drilling fluid, it would not be deposited in filtercake formed on the wellbore walls. Accordingly, a person of ordinary skill in the art would not be motivated to make such a modification, nor expect success from such a modification.

In view of the foregoing, Applicants submit that a prima facie case of obviousness over Terry has not been and cannot be established with respect to claims 16 – 18 and 38 – 40. Accordingly, Applicants respectfully request that the rejection of claims 16 – 18 and 38 – 40 under 35 USC § 103(a) over Terry be withdrawn.

E. Rejection of Claims 2, 3, 27 and 28 under 35 USC § 103(a)

Claims 2, 3, 27 and 28 stand rejected under 35 USC § 103(a) as being unpatentable over Terry. This rejection is respectfully traversed.

Each of claims 2 and 3 depends directly from claim 1, and therefore each includes at least the same elements as claim 1. Each of claims 27 and 28 depends directly from claim 25, and therefore each includes at least the same elements as claim 25. Thus, each of claims 2, 3, 27 and 28 is drawn to a method in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud.

To sustain the present rejection of claims 2, 3, 27 and 28 under 35 USC § 103(a) over Terry, the criteria set forth in MPEP § 2142 must be satisfied. In the present case, Terry fails to satisfy any of the criteria set forth in MPEP § 2142 with respect to these claims.

As discussed above with respect to the rejection of claims under 35 USC §§ 102(b) and 103(a) over Terry, Terry fails to disclose, motivate, or suggest methods in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud. Accordingly, Terry cannot satisfy at least one of the elements of a prima facie case of obviousness against claims 2, 3, 27 and 28, and therefore the entire case must fail.

Also as discussed above with respect to the rejection of claims under 35 USC § 103(a) over Terry, there is no motivation or suggestion to modify the methods described by Terry so as

to provide zeolite in a fluid other than a drilling fluid, nor is there a reasonable expectation of success for doing so.

Furthermore, claims 2, 3, 27 and 28 describe types of zeolite. Terry is completely devoid of disclosure as to the type of zeolite to be included in his methods, and more particularly, to the specific zeolites recited in the Markush groups of claims 3 and 28. Selection of a zeolite as recited in these claims would not be suggested or motivated by the disclosure of Terry because it is known to those of ordinary skill in the art that different zeolites have different properties. It is also known to those of ordinary skill in the art that the reason for selecting different zeolites, as well as a reason for synthesizing different zeolites, is that each has different properties, some of which properties are desirable for certain applications, while other properties are desirable for other applications. As of 2002, the JCPS – International Centre for Diffraction Data, had identified 1,214 synthetic zeolites from 105 classifications, and 278 natural zeolites from 77 subgroups in 45 classifications. Of the numerous possibilities, selection of the zeolite as described in the present claims would not have been an obvious or routine design choice.

In view of the foregoing, Applicants respectfully submit that Terry fails to meet the standard required by MPEP § 2131 to sustain the present rejection of claims 2, 3, 27 and 28 under 35 USC § 103(a). Applicants further submit that Terry entirely fails to disclose, motivate or suggest the subject matter of each of claims 2, 3, 27 and 28, and therefore request that the present rejection of these claims under 35 USC § 103(a) be withdrawn.

F. Rejection of Claims 23, 24, 45 and 46 under 35 USC § 103(a)

Claims 23, 24, 45 and 46 stand rejected under 35 USC § 103(a) over Terry, as applied to claims 1 and 25, and further in view of U.S. Patent No. 5,964,692 to Blezard et al. ("Blezard"). This rejection is respectfully traversed.

Each of claims 23 and 24 depends from claim 1, and therefore each includes at least the same elements as claim 1. Each of claims 45 and 46 depends from claim 25, and therefore each includes at least the same elements as claim 25. Thus, each of claims 23, 24, 45 and 46 is drawn to a method in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud.

To sustain the present rejection of claims 23, 24, 45 and 46 under 35 USC § 103(a) over Terry and Blezard, the criteria set forth in MPEP § 2142 must be satisfied. However, as discussed above with respect to the rejection of claims under 35 USC §§ 102(b) and 103(a) over Terry, Terry fails to disclose, motivate, or suggest methods in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud.

Blezard fails to provide the subject matter that is lacking in Terry. Blezard describes drilling fluids that include water, a type of surfactant, and a functional material, which in some examples, may be zeolite. However, Blezard is completely devoid of disclosure, motivation or suggestion of a method in which a mud is present in a wellbore, and a wellbore treating fluid containing zeolite is brought into contact with that mud. Thus, even if Terry and Blezard could be combined, the resulting combination would not disclose, motivate or suggest all of the elements of claims 23, 24, 45 and 46. Accordingly, at least one of the elements of a prima facie case of obviousness against claims 23, 24, 45 and 46 cannot be satisfied, and therefore the entire case must fail.

Moreover, there is no motivation or suggestion to modify the disclosures of Terry and Blezard so as to achieve the subject matter described in claims 23, 24, 45 and 46, nor is there a reasonable expectation of success for doing so. As discussed above, to modify the method of Terry such that the zeolite is in a wellbore treating fluid that is brought into contact with a mud already present in the wellbore would render the method of Terry inoperable for its intended purpose. According to Terry, it is essential that the zeolite be included in the drilling fluid, rather than in a wellbore treating fluid as described in claims 23, 24, 45 and 46. Blezard does not provide a motivation or suggestion for a modification of Terry that could overcome this deficit, nor does Blezard provide motivation or suggestion for modifications of his own methods that could result in the subject matter of claims 23, 24, 45 and 46.

In view of the foregoing, Applicants respectfully submit that Terry and Blezard fail to meet the standard required by MPEP § 2131 to sustain the present rejection of claims 23, 24, 45 and 46 under 35 USC § 103(a). Accordingly, Applicants request that the present rejection of these claims under 35 USC § 103(a) be withdrawn.

G. New Claims 66 – 77

New claims 66 – 77 are drawn to methods for performing operations in a wellbore that include introducing a wellbore treating fluid comprising zeolite and at least one of an oil-based carrier fluid and a synthetic-based carrier fluid into the wellbore, and forming a mass in the wellbore by allowing the wellbore treating fluid to come into contact with a water-based mud residing in the wellbore.


The subject matter described by claims 66 – 77 is similar to the subject matter described in claims 5 – 7, 9, and 30 – 33. Applicants note with appreciation the indication in the current Office Action that claims 5 – 7, 9, and 30 – 33 represent allowable subject matter. Applicants respectfully submit that claims 66 – 77 are allowable over the art of record for at least the same reasons that apply to claims 5 – 7, 9 and 30 – 33.

Conclusion

Claims 1 – 77 are now pending in the present application. In view of the foregoing remarks, allowance of claims 1 – 77 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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